

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JOHANNES A.M. KEMP, HOK K. TANG and PETER MEYER

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Appeal No. 1999-2797  
Application 08/609,875

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ON BRIEF

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Before RUGGIERO, LALL and DIXON, Administrative Patent Judges.  
RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1-7, 9, and 10. Claim 8 has been indicated by the Examiner to contain allowable subject matter. An amendment filed November 25, 1998, which did not amend the claims, was approved for entry by the Examiner.

The claimed invention relates to a handheld control device which includes first and second manual control members and a display screen. Operation of the device is switched from a

scroll-enable mode to a scroll-disable mode by actuation and interruption, respectively, of the second manual control member. Appellants indicate at pages 2-4 of the specification that the required coordinated operation of the first and second manual control members in order to change the screen display minimizes unintentional actuation of the control members.

Claim 1 is illustrative of the invention and reads as follows:

1. A system included on a handheld control device, the system comprising control means provided with a first and a second manual control portion and a display screen, the control means actuating a scroll-enable mode upon actuation of the second manual control portion by a user and, upon the actuating of the scroll-enable mode, the control means being arranged to scroll through a predetermined series of display items in response to actuation of the first manual control portion and to identify visually, each time in response to a scrolling step, a next display item from the series on the display screen, the control means switching to a scroll-disabled mode in response to interruption of actuation of the second manual control portion, the series of display items scrolled being selected from a number of different series of display items by a mode of actuation of the second manual control portion.

The Examiner relies on the following prior art:

Posso et al. (Posso)	5,627,531	May 6, 1997 (filed Sep. 30, 1994)
Macor	5,677,949	Oct. 14, 1997 (filed Dec. 22, 1994)
Kuga	5,686,940	Nov. 11, 1997 (filed Dec. 23, 1994)

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Claims 1-7, 9 and 10 stand finally rejected under 35 U.S.C. § 103. As evidence of obviousness, the Examiner offers Posso in view of Kuga with respect to claims 1-5, and adds Macor to the basic combination with respect to claims 6, 7, 9, and 10.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Brief (Paper No. 19) and Answer (Paper No. 20) for the respective details.

#### OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner, the arguments in support of the rejection and the evidence of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Brief along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-7, 9, and 10. Accordingly, we reverse.

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In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d

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1443, 1444 (Fed. Cir. 1992).

With respect to independent claim 1, the Examiner proposes to modify the menu selection device disclosed by Posso. According to the Examiner (Answer, page 3 which makes reference to the final Office action mailed August 26, 1998, Paper No. 14), Posso discloses the claimed invention except for a second manual control having a scroll enable and a scroll disable mode. To address this deficiency, the Examiner turns to Kuga which, in a description of the prior art at column 1, lines 34-39, describes the operation of a scrolling function on a computer display screen controlled by scroll start and stop keys on a conventional keyboard. In the Examiner's line of reasoning (pages 2 and 3 of the final Office action):

[t]herefore, it would have been obvious to one skill [sic, skilled] in the art at the time the invention was made to have used Kuga's scroll start/stop keys into [sic, in] the device of Posso et al since this is an advantage for Posso's system in order to provide a safety feature when accidentally the scroll key is pressed.

After careful review of the applied prior art references in light of the arguments of record, we are in general agreement with Appellants' position as stated in the Brief. In our view, the Examiner has combined the teachings of the scrolling features

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of the handheld device of Posso with the general teachings of the

scrolling function in the full screen display device of Kuga in some vague manner without specifically describing how the teachings would be combined. Our review of the Examiner's position on the record reveals no indication as to how and where the scroll start and stop keys of Kuga would be implemented on the device of Posso. This does not persuade us that one of ordinary skill in the art having the references before her or him, and using her or his own knowledge of the art, would have gained possession of the claimed subject matter.

We further agree with Appellants (Brief, page 8) that the skilled artisan, looking to modify the handheld display controller of Posso, would not be led to the full screen display control features disclosed by Kuga. In our view, the problems of accidental scrolling caused by inadvertent actuation of scroll controls in a handheld device such as Posso do not exist to any great extent in full screen displays such as Kuga in which the operator's attention is directed to the screen while a scroll action takes place.

It is also our view, that, even assuming arguendo that

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proper motivation were established for modifying Posso with Kuga, there is no indication as to how such modification would address

the particulars of the claim language of independent claim 1, which requires a specific interaction of the operation of the first and second manual control members to implement the claimed scroll enable and disable modes. In order for us to sustain the Examiner's rejection under 35 U.S.C. § 103, we would need to resort to speculation or unfounded assumptions or rationales to supply deficiencies in the factual basis of the rejection before us. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968), rehearing denied, 390 U.S. 1000 (1968).

Accordingly, since the Examiner has not established a prima facie case of obviousness, the rejection of independent claim 1, and claims 2-5 dependent thereon, based on the combination of Posso and Kuga is not sustained.

As to the 35 U.S.C. § 103 rejection of dependent claims 6, 7, 9, and 10 based on the combination of Posso, Kuga, and Macor, we note that Macor was applied solely to address the display series and remote control unit features of these claims. Macor,

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however, does not overcome the innate deficiencies of Posso and

Kuga discussed supra and, therefore, we do not sustain the obviousness rejection of dependent claims 6, 7, 9, and 10.

In conclusion we have not sustained the Examiner's obviousness rejection of any of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 1-7, 9, and 10 is reversed.

REVERSED

JOSEPH F. RUGGIERO	)	
Administrative Patent Judge	)	
	)	
	)	
PARSHOTAM S. LALL	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
JOSEPH L. DIXON	)	
Administrative Patent Judge	)	

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